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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,167	11/03/2003	David W. Brown	U 0132 OS/CRA	3675

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COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

LANG, AMY T

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,167

Applicant(s)

BROWN ET AL.

Examiner

Amy T. Lang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim 3 rejection of Kaylo (US 6,290,830) in view of Dones (US 6,540,942) in office action mailed 04/12/2006 has been withdrawn in light of applicant's arguments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 07/18/2006. In particular, claims 2 and 3. Certain limitations that were not present in the original claims. Thus, the following action is properly made final.

Specification

1. The amendment filed 07/18/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows:

(i) Claim 2 now states, "wherein the metal working lubricant composition has reduced foaming properties in aqueous and nonaqueous metal working formulations," which is not supported by the specification when relating to the metal working lubricant composition.

(ii) Claim 3 now states, "wherein the base catalyzed reaction product is not epoxy functional" and provides "reduced foaming." It is the examiner's position that although Example 3 of the instant specification discloses where the reaction was completed until

no epoxide was left, this reaction is only conducted using one specific embodiment of the claimed formula (II). Furthermore, the specification also discloses in Example 1 another variation of formula (II) wherein the reaction was not completed until no epoxide was left. Therefore, since the variation disclosing no epoxy functional groups is more specific than the instantly claimed formula (II) and this limitation is only claimed using one specific embodiment, it is the examiner's position that the instant specification does not support the claim. Additionally, the instant specification does not support the limitation of "reduced foaming" of the reaction product of formulas (I) and (II) in regards to the electroplating composition.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "wherein the base catalyzed reaction product is not epoxy functional." Attention is drawn formula (II), which represents the base catalyzed reaction product having the formula $R^2X(AO)_nY$, where R^2 is a substituted or unsubstituted organic group. It is the examiner's position that the recitation of "substituted organic group" is so broad that it clearly encompasses, for instance, a

hydroxyl group containing organic moiety. Hence, formula (II) clearly encompasses a polyhydric alcohol. It appears that applicant is arguing that in order for the reaction product to not be epoxy functional, formula (II) must represent a monohydric alcohol (page 15, line 21 through page 16, line 3 of amendment filed 04/12/2006). As explained above that is incorrect. Therefore, this new limitation of epoxy functional groups conflicts with the scope of formula (II) and renders the claim indefinite.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Wiggins (US 6,387,962).

For explanation of the rejection, see office action mailed 04/12/2006.

3. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Kaylo (US 6,290,830).

For explanation of the rejection, see office action mailed 04/12/2006.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen (US 2,375,007) in view of Dones (US 6,540,942).

For explanation of the rejection, see office action mailed 04/12/2006.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaylo (US 6,290,830) in view of Dones (6,540,942) and Deresh (US 4,849,059).

For explanation of the rejection, see office action mailed 04/12/2006.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaylo (US 6,290,830) in view of Gross (US 6,532,973).

For explanation of the rejection, see office action mailed 04/12/2006.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaylo (US 6,290,830) in view of Gross (US 6,532,973) and Deresh (US 4,849,059).

For explanation of the rejection, see office action mailed 04/12/2006.

Response to Arguments

Applicant's arguments filed 07/18/2006 have been fully considered but they are not persuasive.

Specifically, applicant argues (A) that Wiggins neither teaches nor suggests a metal working lubricant with reduced foaming properties in the instant claim 2.

With respect to argument (A), Wiggins discloses a composition that comprises a carrier oil base, which therefore produces a lubricant. The term "metal working" lubricant is intended use in the instant claim 2 and is given no patentable weight. The examiner's position is supported by case law, which holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) and MPEP 2111.02. Furthermore, the claimed reduced foaming properties are inherent to the composition. Since Wiggins disclose the same base catalyzed reaction with the same reactants with a lubricating oil as is instantly claimed, the invention disclosed by Wiggins would therefore also inherently display the same foam reducing properties.

Specifically, applicant argues (B) that Kaylo does not properly meet the claimed limitations in claim 3.

With respect to (B), Kaylo discloses an electrodepositable composition comprised of epichlorohydrin and polyhydric alcohols. Although the alcohol contains more than one epoxy functional group, when more moles of epichlorohydrin than polyhydric alcohol are reacted together, the reaction can be completed until no epoxy functional groups remain. Therefore, the base catalyzed reaction product is not epoxy functional. Furthermore, since the composition is identical to the composition instantly claimed, it would inherently have reduced foaming properties.

Applicants further argue that Kaylo teaches a composition containing no metals. However, Kaylo specifically discloses the use of a leaded composition (Example 1, column 13; Example 2, column 14) for use in electroplating. Kaylo teaches no additional metallic materials at column 10, lines 59-69. At column 2, lines 8-10 Kaylo discloses that metal ions of salts cause defects, for example magnesium nitrate, not metals such as lead.

Specifically, applicant argues (C) that the combination of Larsen and Dones is insufficient to reject the instant claim 2.

With respect to (C), Larsen discloses the combination of a defoamer and lubricating oil in a lubricating composition. Applicants argue that Larsen discloses only certain silicon containing compounds as useful in the composition. However, Larsen

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teaches that only certain other silicon compounds were found to have no use, which does not exclude all other silicon containing compounds.

Applicants further argue that Larsen teaches detergents as foaming agents. However Larsen does teach the beneficial use of a defoaming agent (page 1, left hand column, lines 42-44 of Larsen) and Dones teaches a useful defoaming agent (column 3, lines 45-47 of Dones). Therefore even though the instant specification teaches the reaction product as a surfactant and Larsen discloses these are foaming agents, Dones teaches the identical product as a defoamer and Larsen specifically discloses a defoamer.

Although Dones does not teach a lubricating composition, Dones does teach a defoamer that provides excellent defoaming capabilities (column 4, lines 50-54). Larsen teaches a lubricating composition that includes the addition of a defoamer. Since the defoamer disclosed by Dones is excellent, it is the examiner's position that proper motivation to combine has been demonstrated.

Specifically, applicant argues (D) that the electroplating bath taught by Kaylo differs from the electroplating bath taught by Deresh in the rejection of claim 3.

With respect to (D), Kaylo, as stated above, does disclose an electroplating bath for electroplating lead. Furthermore Kaylo is open to additional additives (column 6, lines 1-5), so that given the advantages disclosed by Deresh, it would have been obvious to include a defoamer in the invention disclosed by Kaylo.

Specifically, applicant argues (E) that the Kaylo does not teach a monohydric alcohol as is instantly claimed in the rejection of claim 3.

With respect to (E), Kaylo discloses a polyhydric alcohol. As stated above, the instantly claimed formula (II) encompasses a polyhydric alcohol when R^2 is a substituted organic group. Therefore, applicant does not strictly claim a monohydric alcohol as is presently argued. When more moles of epichlorohydrin than polyhydric alcohol are reacted together, the reaction can be completed until no epoxy functional groups remain. Therefore, the base catalyzed reaction product is not epoxy functional.

Specifically, applicant argues (F) that Kaylo does not disclose the addition of a defoamer

With respect to (F), Kaylo, as stated above, discloses an electroplating bath that is open to additional additives (column 6, lines 1-5). Therefore, given the advantages disclose by Deresh of incorporating a defoamer in an electroplating bath, it would have been obvious to include a defoamer in the invention disclosed by Kaylo.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Lang whose telephone number is (571) 272-9057. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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Business Center (EBC) at 866-217-9197 (toll-free).

09/07/2006

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